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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/804,903 02/24/97 RIEVELEY

R 22-46836

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EXAMINER

WEDDINGTON, K

ART UNIT

PAPER NUMBER

1614
DATE MAILED:

01/04/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/804,903

Applicant(s)

Rieveley

Examiner

Kevin E. Weddington

Group Art Unit

1614



☒ Responsive to communication(s) filed on Feb 24, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) 4-6, 11-13, 16-18, 25-27, 29, and 37 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 7-10, 14, 15, 19-24, 28, 30-36, and 38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claims 1-38 are presented for examination.

Applicant's preliminary amendment filed February 24, 1997 and information disclosure statement filed May 27, 1999 have been received and entered.

Applicant's election filed November 24, 1999 in response to the restriction requirement of October 19, 1999 has been received and entered. The applicant elected the species insulin (whether administered orally by ingestion or injected) with traverse.

Applicant's traverse of the restriction requirement is not deemed persuasive, therefore, the restriction requirement is hereby withdrawn.

Claims 4-6, 11-13, 16-18, 25-27, 29 and 37 are withdrawn from consideration as being drawn to the non-elected species (37 CFR 1.142(b)).

Claim Rejections - 35 U.S.C. § 112

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is rendered indefinite by the use of the narrower expression "including" which fails to make it clear whether the narrower expression is, in fact, a claim limitation.

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Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-10, 14, 15, 19-24, 28, 30-36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinstock et al. (R).

Weinstock et al. teach an insulin sensitizer, pioglitazone, administered to diabetic mice. (See the enclosed abstract) Note the reference teaches the diabetic mice were also given insulin in the test trial. Note the diabetic mice given the instant combination produced superior results over the insulin only diabetic mice or the pioglitazone only diabetic mice.

The instant invention differs from the cited reference in that the cited reference does not teach the mode, in which, insulin is administered. Note the applicant preferred the insulin to be administered orally or by injection. However, one skilled in the art would have been motivated to administer insulin orally or by injection since the two modes of the administration are well-known in the art.

Claims 1-3, 7-10, 14, 15, 19-24, 28, 30-36 and 38 are not allowed.

The remaining reference listed on the enclosed PTO-892 is cited to show the state of the art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner K. Weddington whose telephone number is (703) 308-1235.

K. Weddington
KEVIN E. WEDDINGTON
PRIMARY EXAMINER
Art Unit 1614

K. Weddington

December 30, 1999